

Application Serial No.: 09/911,399
Amendment dated January 30, 2004
Reply to Office Action dated October 30, 2003

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 2-6, 8-12, and 14-20 are presently active in this case, Claims 14, 15, 18, and 19 having been amended by way of the present Amendment. Claims 1, 7, and 13 have been canceled without prejudice or disclaimer.

In the outstanding Official Action, Claims 2-6, 14-17, 19, and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over JP 7-289321 (the '321 reference) in view of Takagi (Translated Abstract of JP 10-75809). Claims 8-12 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over the '321 reference in view of DE 87 04 923 (the '923 reference). For the reasons discussed below, the Applicant requests the withdrawal of the obviousness rejections.

The basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the reference (or references when combined) must teach or suggest all of the claim limitations.

Claims 16 and 19 of the present application recite rings comprising a band with a first portion having a first ditch portion formed from an outer surface thereof toward an inside thereof, and a second portion having a second ditch portion formed from the outer surface

Application Serial No.: 09/911,399
Amendment dated January 30, 2004
Reply to Office Action dated October 30, 2003

thereof toward an inside thereof, where the first ditch portion and the second ditch portion face each other. Claims 16 and 19 recite that an exposed outer surface of a first stone does not jut from the first ditch portion, and an exposed outer surface of a second stone does not jut from the second ditch portion.

The '321 reference is cited for the teaching of an ornament fitting hole (3) having an inner tapered surface that can receive a jewel (2). The '321 reference does not teach or even suggest a second ditch portion or a second stone.

The Takagi reference is cited for the teaching of the use of two stones fitted onto opposite portions of a ring. However, the Applicant respectfully submits that the Takagi reference teaches away from the present invention, and thus one of ordinary skill in the art would not have been motivated to combine the '321 reference and the Takagi reference to arrive at the present invention as recited in Claims 16 and 19.

The translated abstract of the Takagi reference expressly states that *at least one of the two ornaments (2, 3) is a lumpish object that is attached in a manner protruding outward from the ring section (1)*. The abstract states that to appreciate the appearance and beauty of two ornaments with one ring, the ring is made with one ornament of a lumpish object that protrudes from an opposite side from the center of the ring section. Thus, based on the teachings of the Takagi reference, the addition of a second stone to the ring of the '321 reference would include a lumpish object protruding outward from the ring.

No mention is made in either reference of a second ditch portion, or a second stone having an exposed outer surface that does not jut from a second ditch portion. The Applicant

Application Serial No.: 09/911,399
Amendment dated January 30, 2004
Reply to Office Action dated October 30, 2003

respectfully submits that one of skill in the art would not have been motivated to arrive at the inventions of Claim 16 and 19 absent hindsight considerations. It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicant's structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

Furthermore, the Applicant notes that the present invention recites “the first ditch portion” and “the second ditch portion” in each of claims 16 and 19. They are both non-penetrating portions and cannot be seen at all from the inner surface side of the first portion and the second portion, respectively. Therefore, it is rendered that “the first stone” and “the second stone” cannot be seen at all from the inner surface side of the first portion and the second portion, respectively.

In contrast, the hole (3) depicted in the ‘321 reference is clearly a penetrating hole and a jewel (2) fitted into the hole (3) is clearly apparent from the back surface side. Such a structure shown by the ‘321 reference significantly differs from “the first ditch portion,” “the second ditch portion,” “the first stone” and “the second stone” recited in Claims 16 and 19 of the present application.

Application Serial No.: 09/911,399
Amendment dated January 30, 2004
Reply to Office Action dated October 30, 2003

Therefore, any combination based on the structure of the hole (3) depicted in the '321 reference cannot achieve the structure, object, or favorable effect realized by Claims 16 and 19 of the present application. For example, assuming it is possible to create a ring based on such a combination, when the ring is not worn and looked from the upper side of the hole (3) provided at the first portion side, not only the penetrating hole provided at the second portion but also the second jewel fitted therein can be seen all together.

Thus, the Applicant respectfully requests the withdrawal of the obviousness rejection of Claims 16 and 19. Claims 2-6 and 17 are considered allowable for the reasons advanced for Claim 16 from which they depend. Claims 14, 15, and 20 are considered allowable for the reasons advanced for Claim 19 from which they depend.

Claim 18 of the present application recites a ring comprising, among other features, a band consisting essentially of a first portion having a first ditch portion formed from an outer surface thereof toward an inside thereof, and a second portion having a plurality of second ditch portions formed from the outer surface thereof toward an inside thereof and arranged separately from each other along the outer surface of the second portion. The band is defined as having a uniform thickness about an entire circumference of the band. (See, e.g., Figure 6, and page 9, lines 13-14, of the specification.)

The '321 reference is cited for the teaching of an ornament fitting hole (3) having an inner tapered surface that can receive a jewel (2). The '321 reference does not teach or even suggest second ditch portions. Additionally, the '321 reference teaches away from a band having uniform thickness about an entire circumference of the band where an exposed outer

Application Serial No.: 09/911,399
Amendment dated January 30, 2004
Reply to Office Action dated October 30, 2003

surface of a stone in the first ditch portion does not jut from the first ditch portion, by teaching a band having varying thickness as depicted in Figure 3.

The '923 reference is cited for the teaching of a ring having initials on an opposite portion of the ring from a setting. However, the Applicant respectfully submits that the '923 reference does not teach or suggest a band having uniform thickness about an entire circumference of the band. The '923 reference depicts a ring having a portion with initials that is substantially thicker than the remainder of the ring. Accordingly, neither the '321 reference, nor the '923 reference teaches or suggest a band having uniform thickness about an entire circumference of the band. Thus, a *prima facie* case of obviousness cannot be established with respect to Claim 18 based upon these references.

Similar to the structure of the hole (3) depicted in the '321 reference (as discussed above with respect to Claims 16 and 19), an overhung portion (3) depicted in the '923 reference is also a penetrating hole and a jewel can be seen from a surface (2) side. Therefore, the overhung portion (3) depicted by the '923 reference cannot be considered as "the first portion" having "the first ditch portion" recited in Claim 18 of the present application. In the same manner, therefore, a portion corresponding to the surface (2) of the '923 reference cannot be considered as "the second portion" facing "the first portion" as recited in Claim 18 of the present application.

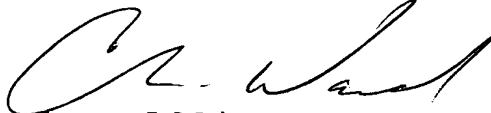
Accordingly, the Applicant respectfully requests the withdrawal of the obviousness rejection of Claim 18. Claims 8-12 are considered allowable for the reasons advanced for Claim 18 from which they depend.

Application Serial No.: 09/911,399
Amendment dated January 30, 2004
Reply to Office Action dated October 30, 2003

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No. 25,599
Attorney of Record

Christopher D. Ward
Registration No. 41,367

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 10/01)

GJM:CDW:brf
I:\atty\cdw\211861US3\am1.doc